

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Stuart A. Fraser et al.
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Examiner : Ann E. Loftus

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AMENDMENT/SUBMISSION

Sir:

This is a response to the Final Office Action mailed September 14, 2007 in the above identified application. Applicants are submitting a Request for Continued Examination for this application concurrently with this Amendment. Reconsideration of the application is respectfully requested. It is noted that the use of the word “we” hereinafter refers to Applicants.

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims, which begins on page 3 of this paper.

Remarks begin on page 10 of this paper.

AMENDMENTS TO THE SPECIFICATION

Please replace the paragraph beginning at page 1, line 4 with the following rewritten paragraph:

This application is a ~~continuation~~ divisional of United States non-provisional application No. 09/553,423, filed April 19, 2000, which claims the benefit of United States provisional application No. 60/131,992, filed April 30, 1999.

LISTING OF THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application:

Claims 1-37 (**Canceled**).

38. (**Currently Amended**) An apparatus comprising at least one computing device having control logic associated therewith that when executed makes the computing device operable to:

receive from a first participant an order for an item;

~~determine a period of time;~~

make the order available to at least a second participant for at least ~~the a~~ predetermined period of time such that the second participant has the ability to trade against the order during at least the predetermined period of time;

receive from the first participant a command to cancel the order;

determine ~~whether that~~ the command to cancel is received ~~during~~ after the predetermined period of time;

cancel the order ~~when~~ based at least in part on determining that the command to cancel is received after the predetermined period of time;

determine that the command to cancel is received during the predetermined period of time; and

~~execute a trading command against not cancel~~ the order ~~when~~ based at least in part on determining that the command to cancel is received during the predetermined period of time.

Claim 39-40 (**Canceled**).

41. (**Previously Presented**) The apparatus of claim 38, in which the item comprises a currency.

Claims 42-44 (**Canceled**).

45. (**Currently Amended**) The apparatus of claim 38, in which the control logic, that when executed, makes the computing device [[is]] further operable to:

receive from the second participant ~~the a trading command; and receive against the~~
order, in which the command to cancel is received during the period of time and prior to
receiving the trading command; and
execute the trading command against the order.

46. **(Currently Amended)** The apparatus of claim [[38]] 45,
in which the order comprises at least one of:

a bid, and
an offer; and

in which the trading command comprises at least one of:

a hit of the bid, and
a lift of the offer.

47. **(Currently Amended)** The apparatus of claim [[38]] 45,
in which to receive the order for the item comprises to receive on a passive side of a
market the order for the item; and
in which the trading command comprises at least one of:
a command to trade all of the passive side of the market,
a hit command to trade down to a first price, and
a lift command to trade up to a second price.

Claims 48-49 **(Canceled)**.

50. **(Currently Amended)** The apparatus of claim 38, in which the control logic, that
when executed, makes the computing device further operable to determine the period of time
comprises to determine the period of time access, based at least on a type of the item, at least
one parameter, in which the at least one parameter comprises a setting for the predetermined
period of time.

51. **(Currently Amended)** The apparatus of claim 38, in which the control logic, that
when executed, makes the computing device further operable to determine the period of time
comprises to access, based at least on the item, at least one parameter, in which the at least
one parameter comprises a setting for to determine the predetermined period of time.

52. **(Currently Amended)** The apparatus of claim 38, in which the control logic, that when executed, makes the computing device ~~[[is]]~~ further operable to:

receive a second order for a second item; and

~~determine~~ make the second order available to at least another participant for at least a second predetermined period of time such that the another participant has the ability to trade against the second order during at least the second predetermined period of time.

53. **(Currently Amended)** The apparatus of claim 52, in which the control logic, that when executed, makes the computing device further operable to:

~~in which to determine the period of time comprises to determine the period of time access,~~ based at least on the item, at least one first parameter, in which the at least one first parameter comprises a first setting for the predetermined period of time; and

~~in which to determine the second period of time comprises to determine the second period of time access,~~ based at least on the second item, at least one second parameter, in which the at least one second parameter comprises a second setting for the second predetermined period of time.

54. **(Currently Amended)** The apparatus of claim ~~[[53]]~~ 52, in which the predetermined period of time for the item is different from the second predetermined period of time for the second item.

Claim 55 **(Canceled)**.

56. **(Currently Amended)** The apparatus of claim 52, in which the control logic, that when executed, makes the computing device further operable to:

~~in which to determine the period of time comprises to determine the period of time access,~~ based at least on a type of the item, at least one first parameter, in which the at least one first parameter comprises a first setting for the predetermined period of time; and

~~in which to determine the second period of time comprises to determine the second period of time access,~~ based at least on a type of the second item, at least one second parameter, in which the at least one second parameter comprises a second setting for the second predetermined period of time.

57. **(Currently Amended)** The apparatus of claim 56, in which the item comprises a first type of currency and the second item comprises a second type of currency.

58. **(Currently Amended)** An apparatus comprising at least one computing device having control logic associated therewith that when executed makes the computing device operable to:

receive from a first participant an order for an item;

~~determine a period of time;~~

make the order available to at least a second participant for at least ~~the a~~ predetermined period of time such that the second participant has the ability to trade against the order during at least the predetermined period of time;

receive from the first participant a command to cancel the order;

in response to the command to cancel, determine ~~whether that~~ the predetermined period of time has lapsed or that the predetermined period of time has not lapsed;

cancel the order ~~when~~ based at least in part on determining that the predetermined period of time has lapsed; and

~~execute a trading command against~~ not cancel the order ~~when~~ based at least in part on determining that the predetermined period of time has not lapsed.

59. **(Currently Amended)** The apparatus of claim ~~[[38]]~~ 58, in which the control logic, that when executed, makes the computing device ~~[[is]]~~ further operable to:

receive from the second participant ~~the a~~ trading command; and receive against the order, in which the command to cancel is received during the period of time and prior to receiving the trading command; and

execute the trading command against the order.

Claims 60-61 **(Canceled)**.

62. **(Currently Amended)** The apparatus of claim 58, in which the control logic, that when executed, makes the computing device further operable to ~~determine the period of time~~ comprises to determine the period of time access, based at least on a type of the item, at least

one parameter, in which the at least one parameter comprises a setting for the predetermined period of time.

63. **(Currently Amended)** The apparatus of claim 58, in which the control logic, that when executed, makes the computing device further operable to determine the period of time comprises to access, based at least on the item, at least one parameter, in which the at least one parameter comprises a setting for to determine the predetermined period of time.

64. **(Currently Amended)** The apparatus of claim 58, in which the control logic, that when executed, makes the computing device [[is]] further operable to:

receive a second order for a second item; and

~~determine~~ make the second order available to at least another participant for at least a second predetermined period of time such that the another participant has the ability to trade against the second order during at least the second predetermined period of time.

65. **(Currently Amended)** The apparatus of claim 64, in which the control logic, that when executed, makes the computing device further operable to:

~~in which to determine the period of time comprises to determine the period of time access,~~ based at least on the item, at least one first parameter, in which the at least one first parameter comprises a first setting for the predetermined period of time; and

~~in which to determine the second period of time comprises to determine the second period of time access,~~ based at least on the second item, at least one second parameter, in which the at least one second parameter comprises a second setting for the second predetermined period of time.

66. **(Currently Amended)** The apparatus of claim 64, in which the predetermined period of time is different from the second predetermined period of time.

67. **(Currently Amended)** An apparatus comprising at least one computing device having control logic associated therewith that when executed makes the computing device operable to:

receive from a first participant an order for an item;

~~determine a period of time;~~

make the order available to at least a second participant for at least ~~the a~~ predetermined period of time such that the second participant has the ability to trade against the order during at least the predetermined period of time;

receive from the first participant a command to cancel the order;

in response to the command to cancel, determine ~~whether~~ that the order has been made available to the at least second participant for at least the predetermined period of time or that the order has not been made available to the at least second participant for at least the predetermined period of time;

cancel the order ~~when~~ based at least in part on determining that the order has been made available to the at least second participant for at least the predetermined period of time; and

~~execute a trading command against~~ not cancel the order ~~when~~ based at least in part on determining that the order has not been made available to the at least second participant for at least the predetermined period of time.

68. **(Currently Amended)** The apparatus of claim 67, in which the control logic, that when executed, makes the computing device ~~[[is]]~~ further operable to:

receive from the second participant ~~the a~~ trading command; ~~and receive against the order, in which~~ the command to cancel is received during the period of time and prior to receiving the trading command; and

execute the trading command against the order.

Claims 69-70 **(Canceled)**.

71. **(Currently Amended)** The apparatus of claim 67, in which the control logic, that when executed, makes the computing device further operable to ~~determine the period of time comprises to determine the period of time~~ access, based at least on a type of the item, at least one parameter, in which the at least one parameter comprises a setting for the predetermined period of time.

72. **(Currently Amended)** The apparatus of claim 67, in which the control logic, that when executed, makes the computing device further operable ~~to determine the period of time~~

~~comprises~~ to access, based at least on the item, at least one parameter, in which the at least one parameter comprises a setting for to determine the predetermined period of time.

73. **(Currently Amended)** The apparatus of claim 67, in which the control logic, that when executed, makes the computing device [[is]] further operable to:

receive a second order for a second item; and

~~determine~~ make the second order available to at least another participant for at least a second predetermined period of time such that the another participant has the ability to trade against the second order during at least the second predetermined period of time.

74. **(Currently Amended)** The apparatus of claim 73, in which the control logic, that when executed, makes the computing device further operable to:

~~in which to determine the period of time comprises to determine the period of time access,~~ based at least on the item, at least one first parameter, in which the at least one first parameter comprises a first setting for the predetermined period of time; and

~~in which to determine the second period of time comprises to determine the second period of time access,~~ based at least on the second item, at least one second parameter, in which the at least one second parameter comprises a second setting for the second predetermined period of time.

75. **(Currently Amended)** The apparatus of claim 73, in which the predetermined period of time is different from the second predetermined period of time.

REMARKS/ARGUMENTS

Claims **38, 41, and 45-75** were pending in this application. According to the September 14, 2007 Final Office Action, claims **38, 41, and 45-75** were rejected.

We have amended independent claims **38, 58, and 67**, and have amended dependent claims **45-47, 50-54, 56-57, 59, 62-66, 68, and 71-75** to recite particular embodiments that we, in our business judgment, have currently determined to be commercially desirable. We have canceled dependent claims **48-49, 55, 60-61, and 69-70**. The limitations of claims **48, 60, and 69** have been added to independent claims **38, 58, and 67** respectively. We will pursue the subject matter of the previously presented and canceled claims in one or more continuing applications. The amendments do not introduce any new matter.

Accordingly, the following claims are under consideration:

- Independent claims **38, 58, and 67**.
- Dependent claims **41, 45-47, 50-54, 56-57, 59, 62-66, 68, and 71-75**.

1.0 Parent Application

At paragraph 1, page 2, of the Office Action, the Examiner indicated that the present application is a continuation in part of the parent application. We note that the present application is a continuation of the parent application and not a continuation in part. In addition, we have amended the Specification at page 1 to further indicate that the present application is a divisional of the parent application.

2.0 Response to the Rejection of the Claims under 35 U.S.C. § 101

At paragraphs 4-5, pages 2-3, of the Office Action, the Examiner rejected previously presented claims **38, 58, and 67** under 35 U.S.C. § 101 because “the claimed invention is directed to two classes of matter.” We respectfully disagree.

Specifically, the Examiner indicated that claims **38, 58, and 67** “embrace or overlap *two* different statutory classes of invention as set forth in 35 U.S.C. 101” and in particular, indicated that the “claims begin by claiming an apparatus but no structure of the apparatus is given,” and that the “claim bodies deal with method steps: determining, receiving, determining, canceling, and executing.” In support of these assertions, the Examiner made reference to Ex parte Lyell, indicating that “[a] claim of this type is precluded by the express language of 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.” Ex parte Lyell, 17 USPQ2d 1548, 1551 (BPAI 1990).

First, Ex parte Lyell does not provide support for the Examiner's assertions and does not apply to claims **38, 58, and 67**. Specifically, the claim on appeal in Ex parte Lyell was a single claim that claimed both an apparatus and the method steps of using the apparatus. Ex parte Lyell, 17 USPQ2d at 1549. Claims **38, 58, and 67** do not recite both an apparatus and the method steps of using the apparatus, nor does the Examiner even assert that claims **38, 58, and 67** recite both an apparatus and the method steps of using the apparatus. As such, Ex parte Lyell is not relevant.

Second, MPEP § 2173 states that "[t]here are many situations where claims are permissively drafted to include a reference to more than one statutory class of invention." MPEP § 2173.05(p). As an example, the MPEP indicates that "[a] product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper." MPEP § 2173.01(p)(I). In accordance with MPEP § 2173.05(p), claims **38, 58, and 67** merely use one statutory class of invention (i.e., process type limitations) to define another statutory class (i.e., an apparatus) and are thereby proper.

Accordingly, we respectfully request withdrawal of the rejection of claims **38, 58, and 67** under 35 U.S.C. § 101.

3.0 Response to the Rejection of the Claims under 35 U.S.C. § 112, First Paragraph

At paragraph 6, pages 3-4, of the Office Action, the Examiner rejected previously presented claims **38, 48-53, 58, 60-65, 67, and 69-74** under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner failed to establish a *prima facie* case of lack of enablement with respect to any of these claims.

3.1 Claims 38, 52, 58, 64, 67, and 73: Determine a period of time

Regarding previously presented claims **38, 52, 58, 64, 67, and 73** and the limitation "*determine a ... period of time*," the Examiner asserted that the Specification "does not discuss how to determine an effective range" and that "[i]t would take undue experimentation to discover a period of time that enables the invention."

MPEP § 2164 states that:

[a] conclusion of lack of enablement means that, based on the **evidence** ..., the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

(emphasis added) MPEP §§ 2164.01(a) and 2164.04.

Contrary to MPEP § 2164, the Examiner failed to provide any objective evidence of record to support a conclusion of undue experimentation. Rather, the Examiner based a conclusion of undue experimentation on purely speculative statements including, for example:

Suppose the period determined ... had indefinite start and stop times, or had already passed or was entirely in the future ... Even if a length of time, such as ten years or ten nanoseconds, was chosen, it might not work [in that] [t]en years is too long to be practical and ten nanoseconds is too short to be effective.

Such statements, unsupported by any objective evidence, are insufficient on which to base a conclusion of undue experimentation. Accordingly, the Examiner failed to establish a *prima facie* case of lack of enablement with respect to previously presented claims **38, 52, 58, 64, 67, and 73**.

Regarding currently presented claims **38, 52, 58, 64, 67, and 73**, these claims have been amended to remove the limitation “*determine a ... period of time*” and as such, the rejection is now moot. However, if the Examiner wishes to maintain the rejection of these claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, we respectfully request that the Examiner provide objective evidence of record on which to base a conclusion of undue experimentation.

**3.2 Claims 48-51, 53, 60-63, 65, 69-72, and 74: Determining
a period of time based on an item ...**

Regarding previously presented claims **48-51, 53, 60-63, 65, 69-72, and 74**, the Examiner asserted that

[a] person of ordinary skill in the art at the time of the invention would not know how to determine a period of time based on an item ... in such a way as to use the invention.

First, we note that previously presented claims **48, 60, and 69** do not recite limitations as asserted by the Examiner in the rejection and as such, the Examiner’s rejection does not appear to apply to these claims.

Second, regarding claims **49-51, 53, 61-63, 65, 70-72, and 74**, contrary to MPEP § 2164, the Examiner failed to provide any objective evidence of record to support the above speculative statements and as such, these statements are insufficient on which to base a

conclusion of undue experimentation. Accordingly, the Examiner failed to establish a *prima facie* case of lack of enablement with respect to these claims.

Regarding currently presented claims **49-51, 53, 61-63, 65, 70-72, and 74**, as indicated above claims **49, 61, and 70** have been canceled and claims **50-51, 53, 62-63, 65, 71-72, and 74** have been amended. Again, if the Examiner wishes to maintain the rejection of claims **50-51, 53, 62-63, 65, 71-72, and 74** under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement we respectfully request that the Examiner provide objective evidence of record on which to base a conclusion of undue experimentation.

4.0 Response to the Rejection of the Claims under 35 U.S.C. § 112, Second Paragraph

At paragraph 7, pages 4-5, of the Office Action, the Examiner rejected previously presented claims **38, 52-56, 58, 64-67, and 73-75** under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter.

4.1 Claims 38, 58, and 67: Apparatus and method steps

Regarding claims **38, 58, and 67**, the Examiner asserted that “the claims begin as an apparatus and then describe method steps instead of structure [and] [t]hus it is not clear what statutory class is claimed.” As indicated above, the form of claims **38, 58, and 67** is proper. As such, the rejection of these claims under 35 U.S.C. § 112, second paragraph, is improper and it is respectfully requested that the rejection be withdrawn.

4.2 Claims 38, 58, and 67: Computing device

Regarding previously presented claims **38, 58, and 67**, the Examiner also asserted that

the term ‘computing device’ is unclear. While the central concept of a computing device is understood, the boundaries of its definition are not clear. Is a watch a computing device? Is a pencil a computing device? Is a telephone a computing device? The metes and bounds of the claim are unclear.

MPEP § 2173 states that under 35 U.S.C. § 112, second paragraph,

[t]he requirement to ‘distinctly’ claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles.... **Only when a claim remains insolubly ambiguous without a discernible meaning**

after all reasonable attempts at construction must a court declare it indefinite.

(emphasis added); MPEP § 2173.02.

The Examiner failed to show how the term “*computing device*” is “insolubly ambiguous without a discernible meaning.” In particular, we note that the Examiner stated that “the central concept of a computing device is understood,” thereby appearing to acknowledge that the term “*computing device*” is not “insolubly ambiguous without a discernible meaning.” Accordingly, the Examiner failed to establish a *prima facie* case of indefiniteness with respect to these claims.

Notably, in rejecting these claims the Examiner also appeared to question the breadth of the term “*computing device*” (“Is a watch a computing device? Is a pencil a computing device? Is a telephone a computing device?”). Assuming the Examiner was making such a rejection, we note that MPEP § 2173 states that the

[b]readth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

(emphasis added); MPEP §§ 2173.04. Accordingly, the breadth of the term “*computing device*” does not make claims **38**, **58**, and **67** indefinite.

Regarding currently presented claims **38**, **58**, and **67**, these claims have been amended to recite “*An apparatus comprising at least one computing device having control logic associated therewith that when executed makes the computing device operable to...*” It is respectfully submitted that term “*computing device*” as recited by these claims is also not “insolubly ambiguous without a discernible meaning.”

4.3 Claims 38, 58, and 67: Making an order available

Regarding previously presented claims **38**, **58**, and **67**, the Examiner also asserted that “making an order available might mean available for reading as opposed to available for bidding.” Again, while the Examiner asserted that the phrase to “*make an order available*” is indefinite, the Examiner also provided alternative meanings for this phrase. Accordingly, the phrase to “*make an order available*” as recited by claims **38**, **58**, and **67** is not “insolubly

ambiguous without a discernible meaning.” The Examiner thereby failed to establish a *prima facie* case of indefiniteness with respect to these claims.

In addition, assuming that the Examiner may have been rejecting claims **38**, **58**, and **67** because of the breadth of the phrase to “*make an order available*,” we again note that the breadth of a claim does not make the claim indefinite.

Regarding currently presented claims **38**, **58**, and **67**, these claims have been amended to recite to “*make the order available to at least a second participant for at least a predetermined period of time such that the second participant has the ability to trade against the order during at least the period of time*.” It is respectfully submitted that the phrase to “*make an order available*” as recited by these claims is also not “insolubly ambiguous without a discernible meaning.”

4.4 Claim 55: Value of zero

Regarding previously presented claim **55**, the Examiner asserted that:

the phrase ‘value of zero’ is unclear. A period of time does not have a resale value. Does a period of time with a length of zero exist at all? How is it determined?

Again, while the Examiner asserted that the phrase “*value of zero*” is indefinite, the Examiner also appeared to provide alternative meanings for this phrase, including a length of time. Accordingly, the phrase “*value of zero*” as recited by claim **55** is not “insolubly ambiguous without a discernible meaning” and the Examiner thereby failed to establish a *prima facie* case of indefiniteness with respect to this claim.

Regarding the question “[h]ow is it determined,” with this question the Examiner also appeared to reject claim **55** under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Assuming the Examiner was making such a rejection, we note that the Examiner failed to provide any objective evidence of record to support a conclusion of undue experimentation regarding the determination of such a value. Accordingly, the Examiner also failed to establish a *prima facie* case of lack of enablement with respect to this claim.

Nonetheless, as indicated above claim **55** has been canceled and the rejection of this claim is therefore now moot.

4.5 Claims 52-56, 64-66, and 73-75: Second period of time

Regarding previously presented claims **52-56, 64-66, and 73-75**, the Examiner asserted that “it is unclear as to the relevance of the second period of time after it is determined. How does it affect the apparatus?”

We submit that merely questioning the “relevance of the second period of time” as asserted by the Examiner does not make these claims “insolubly ambiguous without a discernible meaning.” Accordingly, we submit that the Examiner failed to establish a *prima facie* case of indefiniteness with respect to these claims.

Regarding currently presented claims **52-56, 64-66, and 73-75**, as indicated above claim **55** has been canceled and claims **52-54, 56, 64-66, and 73-75** have been amended. In particular, claims **52, 64, and 73** now recite to “*make the second order available to at least another participant for at least a second predetermined period of time such that the another participant has the ability to trade against the second order during at least the second predetermined period of time.*” It is respectfully submitted that currently presented claims **52-54, 56, 64-66, and 73-75** are also not “insolubly ambiguous without a discernible meaning.”

4.6 Claims 58 and 67: If an order first arrives ...

Regarding previously presented claims **58 and 67**, the Examiner asserted that “if an order first arrives during the period, then it will first be executed and then also be cancelled when the period ends.”

We respectfully disagree with the Examiner’s statements. Nonetheless, as indicated above, claims **58 and 67** have been amended and it is respectfully submitted that the Examiner’s rejection is now moot in view of the amendments.

5.0 Response to the Rejection of Claims under 35 U.S.C. § 102(b)

At paragraphs 8-9, pages 5-7, of the Office Action, the Examiner rejected previously presented claims **38, 41, and 45-75** under 35 U.S.C. § 102(b) as being anticipated by Wiseman, U.S. Patent No. 5,168,446 (hereinafter Wiseman).

5.1 Independent Claim 38

In rejecting previously presented claim **38**, the Examiner asserted that:

Wiseman teaches in column 19 lines 35-55 a period of time when a cancel command is inoperative. Determining a period of time is inherent in the way the proposal state affects actions. In this case, the period of time is from the beginning of the proposal state until the proposal is changed. Wiseman teaches canceling the order when the command to cancel is received after the period of time....

Accordingly, in rejecting claim 38, the Examiner asserted that to “*determine a period of time*” as recited by claim 38 is inherent in the teachings of Wiseman column 19 lines 35-55 and similarly, also appeared to assert that to “*determine whether the command to cancel is received during the period of time*” as recited by claim 38 is also inherent in the teachings of Wiseman column 19 lines 35-55. With respect to rejecting a claim based on inherency, MPEP § 2112 states that

[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.... ‘In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.’

(internal quotes omitted); MPEP § 2112 (IV).

Contrary to MPEP § 2112, in rejecting claim 38 the Examiner failed to provide any objective evidence and/or technical reasoning that to “*determine a period of time*” or to “*determine whether the command to cancel is received during the period of time*” as recited by claim 38 necessarily flow from the teachings of Wiseman column 19 lines 35-55. The Examiner only asserted that there is a period of time “from the beginning of the proposal state until the proposal is changed.” However, even assuming, *arguendo*, that there is a period of time as asserted by the Examiner, the mere existence of this period of time is insufficient to support a determination that Wiseman at column 19 lines 35-55 necessarily “determine[s] *whether the command to cancel is received during [this] period of time,*” let alone even “determine[s] *[this] period of time.*” Accordingly, the Examiner failed to provide objective evidence and technical reasoning to support a determination of inherency.

In addition, we note that at column 19 lines 35-55 Wiseman discloses that

[t]he CANCEL field can be used to terminate any communication link at any stage of a transaction, provided the transaction is not in the proposal state (where a proposal has been sent) or any subsequent stage. However, a transaction that has reached the proposal stage can still be canceled if the proposal is CHANGED

and one of the parties touches CANCEL twice before a new proposal is received.

Accordingly, at column 19 lines 35-55 Wiseman appears to disclose that for a transaction that has reached the proposal stage, the transaction can still be canceled if the proposal is CHANGED. Even assuming, *arguendo*, that there is a period of time “from the beginning of the proposal state until the proposal is changed” as asserted by the Examiner, Wiseman at column 19 lines 35-55 does not appear to disclose or even have a need to “*determine whether the command to cancel is received during [this] period of time,*” let alone to even “*determine [this] period of time.*” Wiseman only appears to need to determine if the proposal is CHANGED in order to cancel a transaction and determining if the proposal is CHANGED is not and does not necessarily mean that Wiseman also “*determine[s] [the] period of time*” or “*determine[s] whether the command to cancel is received during the period of time.*” Again, the mere existence of a period of time “from the beginning of the proposal state until the proposal is changed” is insufficient to support a determination that Wiseman at column 19 lines 35-55 necessarily “*determine[s] [this] period of time*” or “*determine[s] whether the command to cancel is received during [this] period of time,*” as recited by claim 38. Accordingly, these limitations do not necessarily flow from the teachings of Wiseman column 19 lines 35-55 and as such, these limitations are not inherently disclosed by Wiseman column 19 lines 35-55.

Accordingly, for the foregoing reasons, the Examiner failed to establish that to “*determine a period of time*” and to “*determine whether the command to cancel is received during the period of time*” are inherent in the teachings of Wiseman column 19 lines 35-55 and as such, failed to establish a *prima facie* case of anticipation with respect to previously presented claim 38.

Tuning to currently presented claim 38, it recites in part to:

determine that the command to cancel is received after the predetermined period of time;

cancel the order based at least in part on determining that the command to cancel is received after the predetermined period of time;

determine that the command to cancel is received during the predetermined period of time; and

not cancel the order based at least in part on determining that the command to cancel is received during the predetermined period of time.

For reasons similarly discussed above, at column 19 lines 35-55 Wiseman does not expressly or inherently disclose to “determine that the command to cancel is received after the predetermined period of time” or to “determine that the command to cancel is received during the predetermined period of time,” as recited by claim 38.

5.2 Independent Claim 58

In rejecting previously presented claim 58, the Examiner asserted that

in order for the system to be able to decide to not accept the cancel command during the period when the command should be inoperative, ...it inherently must determine in response to the command to cancel whether the period of time has lapsed.

Accordingly, in rejecting claim 58, the Examiner asserted that “determin[ing] in response to the command to cancel whether the period of time has lapsed” is inherent in the teachings of Wiseman column 19 lines 35-55. Contrary to MPEP § 2112, the Examiner failed to provide any objective evidence and/or technical reasoning that “determin[ing] in response to the command to cancel whether the period of time has lapsed” necessarily flows from the teachings of Wiseman column 19 lines 35-55. Specifically, the Examiner merely asserted that (a) “for the system [of Wiseman] to be able to decide to not accept the cancel command during the period when the command should be inoperative” the system (b) “must determine ... whether the period of time has lapsed.” However, the Examiner failed to provide any objective evidence and/or technical reasoning that statement (b) necessarily flows from statement (a). Accordingly, the Examiner failed to provide objective evidence and technical reasoning to support a determination of inherency.

In addition, as discussed above, at column 19 lines 35-55 Wiseman appears to disclose that for a transaction that has reached the proposal stage, the transaction can still be canceled if the proposal is CHANGED. Even assuming, *arguendo*, that there is a period of time “from the beginning of the proposal state until the proposal is changed” as asserted by the Examiner, Wiseman at column 19 lines 35-55 does not appear to disclose or even have a need to “determine whether [this] period of time has lapsed,” as recited by claim 58. Wiseman only appears to need to determine if the proposal is CHANGED “in order for the system to be able to decide to not accept the cancel command” and determining if the

proposal is CHANGED is not and does not necessarily mean that Wiseman also “*determine[s] whether the period of time has lapsed.*” Accordingly, “*in response to the command to cancel, determin[ing] whether the period of time has lapsed*” does not necessarily flow from the teachings of Wiseman column 19 lines 35-55 and as such, this limitation is not inherently disclosed by Wiseman column 19 lines 35-55.

Accordingly, for the foregoing reasons, the Examiner failed to establish that “*in response to the command to cancel, determine whether the period of time has lapsed*” is inherent in the teachings of Wiseman column 19 lines 35-55 and as such, failed to establish a *prima facie* case of anticipation with respect to previously presented claim **58**.

Tuning to currently presented claim **58**, it recites in part:

in response to the command to cancel, determine that the predetermined period of time has lapsed or that the predetermined period of time has not lapsed;

cancel the order based at least in part on determining that the predetermined period of time has lapsed; and

not cancel the order based at least in part on determining that the predetermined period of time has not lapsed.

For reasons similarly discussed above, at column 19 lines 35-55 Wiseman does not expressly or inherently disclose such limitations.

5.3 Independent Claim 67

In rejecting previously presented claim **67**, the Examiner asserted that

since Wiseman’s proposal state begins when the proposal is sent to a second participant, the order has been available to the second participant since the beginning of the period of time.... The period of time is thus equivalently chosen as from the point when the proposal is available to the second participant until the proposal is changed, so that Wiseman teaches in response to the command to cancel, determining whether the order has been made available to the at least second participant for at least the period of time.

Accordingly, in rejecting claim **67**, the Examiner appeared to assert that “*in response to the command to cancel, determin[ing] whether the order has been made available to the at least second participant for at least the period of time*” as recited by claim **67** is inherent in the teachings of Wiseman column 19 lines 35-55. Contrary to MPEP § 2112, the Examiner failed to provide any objective evidence and/or technical reasoning that “*in response to the*

command to cancel, determin[ing] whether the order has been made available to the at least second participant for at least the period of time” necessarily flows from the teachings of Wiseman column 19 lines 35-55. Specifically, the Examiner merely asserted that there is a “period of time [that] is ... equivalently chosen as from the point when the proposal is available to the second participant until the proposal is changed” and similarly, appeared to assert that an order is available during this period of time. However, even assuming, *arguendo*, that there is such a period of time and that an order is available during this period of time as asserted by the Examiner, the mere existence of this period of time and the availability of an order during this period of time is insufficient to support a determination that Wiseman at column 19 lines 35-55 necessarily “*determine[s] whether the order has been made available to the at least second participant for at least [this] period of time.*” Accordingly, the Examiner failed to provide objective evidence and technical reasoning to support a determination of inherency.

In addition, as indicated above, at column 19 lines 35-55 Wiseman appears to disclose that for a transaction that has reached the proposal stage, the transaction can still be canceled if the proposal is CHANGED. Even assuming, *arguendo*, that there is a period of time and that an order is available during this period of time as asserted by the Examiner, Wiseman at column 19 lines 35-55 does not appear to disclose or even have a need to “*determine whether the order has been made available to the at least second participant for at least [this] period of time.*” Wiseman only appears to need to determine if the proposal is CHANGED in order to cancel a transaction and determining if the proposal is CHANGED is not and does not necessarily mean that Wiseman also “*determine[s] whether the order has been made available to the at least second participant for at least the period of time.*” Again, the mere existence of a period of time and the availability of an order is during this period of time is insufficient to support a determination that Wiseman at column 19 lines 35-55 necessarily “*determine[s] whether the order has been made available to the at least second participant for at least [this] period of time,*” as recited by claim 67. Accordingly, this limitation does not necessarily flow from the teachings of Wiseman column 19 lines 35-55 and as such, this limitation is not inherently disclosed by Wiseman column 19 lines 35-55.

Accordingly, for the foregoing reasons, the Examiner failed to establish that “*in response to the command to cancel, determine whether the order has been made available to the at least second participant for at least the period of time*” is inherent in the teachings of

Wiseman column 19 lines 35-55 and as such, failed to establish a *prima facie* case of anticipation with respect to previously presented claim 67.

Tuning to currently presented claim 67, it recites in part to:

in response to the command to cancel, determine that the order has been made available to the at least second participant for at least the predetermined period of time or that the order has not been made available to the at least second participant for at least the predetermined period of time;

cancel the order based at least in part on determining that the order has been made available to the at least second participant for at least the predetermined period of time; and

not cancel the order based at least in part on determining that the order has not been made available to the at least second participant for at least the predetermined period of time.

For reasons similarly discussed above, at column 19 lines 35-55 Wiseman does not expressly or inherently disclose such limitations.

5.4 Dependent Claims 41, 45-46, 52, 57, 59, 64, 68, and 73

Previously presented dependent claims 41, 45-46, 52, 57, 59, 64, 68, and 73 depend from independent claims 38, 58, and 67 and as such, the Examiner failed to establish a *prima facie* case of anticipation with respect to these claims for at least the same reasons as set forth above for claims 38, 58, and 67.

Similarly, currently presented dependent claims 41, 45-46, 52, 57, 59, 64, 68, and 73 depend from independent claims 38, 58, and 67 and as such, Wiseman column 19 lines 35-55 does not expressly or inherently disclose certain limitations of these claims as discussed above.

5.5 Dependent Claims 47-51, 53-56, 60-63, 65-66, 69-72, and 74-75

As indicated, at paragraph 9, page 5, of the Office Action, the Examiner rejected previously presented claims 47-51, 53-56, 60-63, 65-66, 69-72, and 74-75 as being anticipated by Wiseman. However, at page 7 of the Office Action the Examiner merely asserted that these “remaining claims are rejected as depending on rejected parents.”

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

The Examiner failed to show that Wiseman discloses each and every element of any of claims **47-51, 53-56, 60-63, 65-66, 69-72, and 74-75** and as such, failed to establish a *prima facie* case of anticipation with respect to these claims.

Regarding currently presented dependent claims **47, 50-51, 53-54, 56, 62-63, 65-66, 71-72, and 74-75** (as indicated, claims **48-49, 55, 60-61, and 69-70** have been canceled), these claims depend from independent claims **38, 58, and 67** and as such, Wiseman column 19 lines 35-55 does not expressly or inherently disclose certain limitations of these claims as discussed above.

6.0 Response to the Rejection of Claims under 35 U.S.C. § 103(a): Wiseman and Bay

At pages 8-9 of the Office Action, the Examiner rejected previously presented claims **48-51, 53-55, 60-63, 65-66, 69-72, and 74-75** under 35 U.S.C. § 103(a) as being unpatentable over Wiseman in view of Bay, U.S. Patent No. 5,347,452 (hereinafter Bay). Because these claims depend from independent claims **38, 58, and 67**, the Examiner failed to establish a *prima facie* case of obviousness with respect to these claims for at least the same reasons as set forth above for claims **38, 58, and 67**.

Regarding currently presented dependent claims **50-51, 53-54, 62-63, 65-66, 71-72, and 74-75**, these claims depend from independent claims **38, 58, and 67** and as such, Wiseman column 19 lines 35-55 does not expressly or inherently disclose certain limitations of these claims as discussed above.

7.0 Response to the Rejection of Claims under 35 U.S.C. § 103(a): Wiseman and Official Notice

At paragraph 10, pages 9-10, of the Office Action, the Examiner rejected previously presented claim **47** under 35 U.S.C. § 103(a) as being unpatentable over Wiseman in view of Official Notice.

Officially-noted subject matter cannot be used as the primary basis for a rejection under § 103. In other words, official notice alone of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art. *see*, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969); In re Eynde, 480 F.2d 1364 (C.C.P.A. 1973); In re Pardo, 684 F.2d 912 (C.C.P.A. 1982). Accordingly, the Examiner failed to establish a *prima facie* case of obviousness with respect to previously presented claim **47**.

If the Examiner wishes to maintain the rejection of currently presented claim **47**, it is requested that the Examiner provide documentary evidence to support the rejection. 37 C.F.R. 1.104(c)(2).

8.0 Conclusion

In view of the foregoing, we submit that claims **38, 41, 45-47, 50-54, 56-59, 62-68, and 71-75** are allowable. Favorable reconsideration and allowance of these claims are therefore requested. We earnestly believe that this application is now in condition to be passed to issue, and such action is also respectfully requested. However, if the Examiner deems it would in any way facilitate the prosecution of this application, the Examiner is invited to telephone our undersigned representative at 212-294-7733.

Respectfully submitted,

/Glen R. Farbanish/

November 1, 2007
Date

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